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PATENT


THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Neubauer, et al
Serial No. : 10/646,414
Filed : August 22, 2003
Patent No. : 6,793,614 B2
Issued : September 21, 2004
Title : Outsert-Forming
Machine and Method

I hereby certify that this paper and the documents referred to herein as being enclosed are being deposited with the United States Postal Service as Express Mail Label No. EV452158889US, postage prepaid, in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450, on this date

Date: January 10, 2005


Richard Zimmermann

EXPEDITED REQUEST FOR CERTIFICATE OF CORRECTION

ATTN: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Certificate
JAN 14 2005
of Correction

Sir:

Pursuant to 37 C.F.R. §1.322, the patentee, through its undersigned attorney, respectfully requests a certificate of correction to be issued, on an expedited basis, for the above-identified U.S. patent correcting the patent as noted in the enclosed "Certificate of Correction" Form PTO-1050.

Two corrections are being requested. As required by M.P.E.P. §1480.01 and discussed below, it is respectfully submitted that both of the requested corrections are to correct mistakes that were made solely through the fault of the Office, and this request is being accompanied by documentation that is believed to unequivocally support that assertion.

The first requested correction is the cancellation of claims 5-8 of the patent. On August 16, 2004, the undersigned representative filed an amendment in the Patent Office, via Express Mail, cancelling claims 5-8 on the basis that it was believed that claims 5-8 were identical to claims 1-4 of the parent patent, U.S. Patent No. 6,645,134. In particular, the remarks portion of the amendment stated the following:

19 JAN 2005

19 JAN 2005

On August 3, 2004, the undersigned representative of applicants left a detailed telephone message for Examiner Tawfik indicating that allowed apparatus claims 5-8 were believed to be identical to claims 1-4 of the parent '134 patent. Examiner Tawfik left a return telephone message suggesting that an amendment under Rule 312 be filed canceling claims 5-8. This amendment is being filed pursuant to that suggestion so that two patents having some identical claims do not issue.

The amendment was received by the Patent Office and was given a filing date of August 16, 2004, as indicated on the enclosed copy of the amendment that was printed from the PAIR system on the Patent Office website. The enclosed copy of the amendment bears the stamp of the Patent Office acknowledging receipt of the document.

The second requested correction, as specified on the enclosed PTO-1050 form, is the acknowledgement to be printed on the face of the patent that the patent is subject to a terminal disclaimer. On August 16, 2004, the undersigned representative filed a terminal disclaimer in the Patent Office via Express Mail. The terminal disclaimer was received by the Patent Office and was given a filing date of August 16, 2004, as indicated on the enclosed copy of the terminal disclaimer that was printed from the PAIR system on the Patent Office website. The enclosed copy of the terminal disclaimer bears the stamp of the Patent Office acknowledging receipt of the document.

Also, as set forth on the enclosed copy of the amendment, a check for payment of the terminal disclaimer filing fee was enclosed and an authorization to charge any additional required fee to our deposit account was given to the Office.

Respectfully submitted,
MARSHALL, GERSTEIN & BORUN LLP

Date: January 10, 2005

By: Martin J. Hirsch
Martin J. Hirsch
Registration No. 32,237
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO. : 6,793,614 *B2*
ISSUED : September 21, 2004
INVENTORS : William Neubauer, et al.

It is certified that errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Starting at column 37, line 24, please cancel claims 5-8, which start at column 37, line 24 and end at column 40, line 8.

In Section (73) on the cover page of the patent, after the sentence following "(*) Notice:", add the following sentence: "This patent is subject to a terminal disclaimer."

MAILING ADDRESS OF SENDER:
Martin J. Hirsch.
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357

PATENT NO.: 6,793,614 *B2*

No. of additional copies:

9 JAN 2005



PATENT

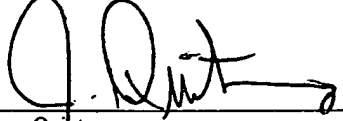
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Neubauer, et al.)
Ser. No. : 10/646,414)
Filed : August 22, 2003)
Title : Outsert-Forming)
Machine and Method)
Art Unit : 3721)
Examiner : Sameh H. Tawfik)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450, on this date:

Date: August 16, 2004


Juan Quiñero

AMENDMENT AFTER ALLOWANCE UNDER 37 C.F.R. §1.312

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Amendments to the claims are reflected by the listing of claims beginning on page 2 of this paper.

Remarks begin on page 6 of this paper.

LISTING OF CLAIMS:

1. (original) A method of forming an outsert having product information printed thereon, said method comprising:

(a) making a first fold in a first direction in a sheet of paper having product information printed thereon with a first folding apparatus by a method comprising:

(a1) feeding a sheet of paper having a leading edge, a trailing edge, and product information printed thereon into said first folding apparatus until said leading edge of said sheet of paper makes contact with a first stop member of said first folding apparatus;

(a2) continuing to feed said sheet of paper through said first folding apparatus with said leading edge of said sheet of paper in contact with said first stop member of said first folding apparatus so that an intermediate portion of said sheet of paper between said leading edge and said trailing edge forms a buckled portion; and

(a3) continuing to feed said sheet of paper through said first folding apparatus to cause said buckled portion of said sheet of paper to pass between a first pair of folding rollers of said first folding apparatus to form a first fold in said sheet of paper in said first direction;

(b) making at least one additional fold in said sheet of paper in a direction parallel to said first fold and said first direction with said first folding apparatus to form a first folded article having a leading edge and a trailing edge by a method comprising:

(b1) continuing to feed said sheet of paper through said first folding apparatus until a leading portion of said sheet of paper coinciding with said first fold makes contact with a second stop member of said first folding apparatus;

(b2) continuing to feed said sheet of paper through said first folding apparatus with said leading portion of said sheet of paper in contact with said second stop member of said first folding apparatus so that an intermediate portion of said sheet of paper between said leading portion and said trailing edge of said sheet of paper forms a buckled portion; and

(b3) continuing to feed said sheet of paper through said first folding apparatus to cause said buckled portion between said leading portion of said sheet of paper and said trailing edge of said sheet of paper to pass between a second pair of folding rollers of said first folding apparatus to form a second fold in said sheet of paper in said first direction;

(c) making a first fold in said first folded article in a second direction perpendicular to said first direction with a second folding apparatus by a method comprising:

(c1) feeding said first folded article into said second folding apparatus until said leading edge of said first folded article makes contact with a first stop member of said second folding apparatus;

(c2) continuing to feed said first folded article through said second folding apparatus with said leading edge of said first folded article in contact with said first stop member of said second folding apparatus so that an intermediate portion of said first folded article between said leading edge of said first folded article and said trailing edge of said first folded article forms a buckled portion; and

(c3) continuing to feed said first folded article through said second folding apparatus to cause said buckled portion of said first folded article to pass between a first pair of folding rollers of said second folding apparatus to form a first fold in said first folded article in said second direction;

(d) making at least one additional fold in said first folded article in said second direction with said second folding apparatus to form a second folded article having a leading edge and a trailing edge by a method comprising:

(d1) continuing to feed said first folded article through said second folding apparatus until a leading portion of said first folded article coinciding with said first fold in said first folded article makes contact with a second stop member of said second folding apparatus;

(d2) continuing to feed said first folded article through said second folding apparatus with said leading portion of said first folded article in contact with said second stop member of said second folding apparatus so that an intermediate portion

of said first folded article between said leading portion of said first folded article and said trailing edge of said first folded article forms a buckled portion; and

(d3) continuing to feed said first folded article through said second folding apparatus to cause said buckled portion between said leading portion of said first folded article and said trailing edge of said first folded article to pass between a second pair of folding rollers of said second folding apparatus to form a second fold in said first folded article in said second direction;

(e) depositing an adhesive on a portion of said second folded article; and

(f) folding said second folded article by making a final fold in said second folded article to form an outsert, said final fold being parallel to said second direction and being made so that said adhesive holds said outsert in a substantially closed position so that said outsert has no exposed unfolded exterior edges that lie in a direction parallel to said final fold, said final fold being made with a third folding apparatus by a method comprising:

(f1) feeding said second folded article into said third folding apparatus until said leading edge of said second folded article makes contact with a stop member of said third folding apparatus;

(f2) causing a movable member of said third folding apparatus to make contact with and move an intermediate portion of said second folded article towards a pair of adjustably-spaced folding rollers that are spaced apart from each other by a distance that is within a range defined by a lower boundary of 0.25 inches and an upper boundary of 0.35 inches; and

(f3) continuing to feed said second folded article through said third folding apparatus so that said intermediate portion of said second folded article passes between said pair of folding rollers of said third folding apparatus to form said final fold in said second folded article.

2. (original) A method as defined in claim 1 additionally comprising automatically conveying said first folded article from said first folding apparatus to said second folding apparatus.

3. (original) A method as defined in claim 1 wherein (c3) comprises feeding said first folded article between a first folding roller and a second folding roller of said second folding apparatus and wherein (d3) comprises feeding said first folded article between said second folding roller and a third folding roller of said second folding apparatus.

4. (original) A method as defined in claim 1 additionally comprising adjusting the position of one of said folding rollers of said third folding apparatus so that said distance between said outer diameters of said folding rollers of said third folding apparatus is greater than 0.35 inches.

Claims 5-8: (canceled)

REMARKS

The present application is a continuation of U.S. Serial No. 09/951,663 filed September 12, 2001, which is now U.S. Patent No. 6,645,134. All claims of the present application, claims 1-8, were allowed via a notice of allowance mailed May 21, 2004.

On August 3, 2004, the undersigned representative of applicants left a detailed telephone message for Examiner Tawfik indicating that allowed apparatus claims 5-8 were believed to be identical to claims 1-4 of the parent '134 patent. Examiner Tawfik left a return telephone message suggesting that an amendment under Rule 312 be filed canceling claims 5-8. This amendment is being filed pursuant to that suggestion so that two patents having some identical claims do not issue. It is respectfully submitted that this amendment does not raise any new issue of patentability.

A terminal disclaimer, a paper entitled "Comment on Reasons for Allowance," the signed issue fee transmittal and a check for payment of the issue fee and the terminal disclaimer filing fee are being filed herewith.

The Office is directed to charge any additional required fee to our Deposit Account No. 13-2855. A duplicate copy of this paper is enclosed.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

Date: August 16, 2004

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Applicants : Neubauer, et al.

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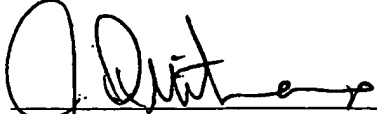
Art Unit : 3721

Examiner : Sameh H. Tawfik

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) Commissioner for Patents
) P.O. Box 1450
) Alexandria, VA 22313-1450, on this date:

) Date: August 16, 2004

) 
) Juan Quintero

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The owner, Vijuk Equipment, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§154 to 156 and 173, as shortened by any terminal disclaimer, of prior U.S. Patent No. 6,645,134. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§154 to 156 and 173 of the prior patent, as shortened by any terminal disclaimer, in the event that the prior patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all

claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is an attorney of record.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

Date: August 16, 2004

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